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2. REMARKS / DISCUSSION OF ISSUES

Claims 1-29 are pending in the application. Claims 1, 8, 14, 19 and 25 are independent claims.

Unless indicated otherwise, claims are amended for non-statutory reasons: to correct one or more informalities, remove figure label number(s), and/or to replace European-style claim phraseology with American-style claim language.

Rejections Under 35 U.S.C. § 102

Claims 1-5, 7-17 and 19-29 were rejected under 35 U.S.C. § 102(e) as being unpatentable over *Taylor*. (U.S. Patent 6,209,004). For at least the reasons set forth below, Applicants respectfully submit that this rejection is improper and should be withdrawn.

Again, Applicants note that the art cited does not qualify as a reference under 35 U.S.C. § 102(e). For at least this reason, this rejection is improper and should be withdrawn.

The Examiner has reiterated substantially verbatim the rejection of the Office Action of January 17, 2006. Applicants respectfully maintain their position as to the patentability of the pending claims as set forth in the Response under Rule 111. Applicants offer additional arguments, primarily in response to the Examiner's 'Response to Arguments' set forth in the present Office Action at pages 12-13.

A proper rejection of a claim under 35 U.S.C. § 102 requires that a single **prior art reference disclose each element of the claim**. *See, e.g., W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303, 313 (Fed. Cir. 1983). **Anticipation requires that each and every element of the claimed invention be disclosed in a single prior art reference**. *See, e.g., In re Paulsen,* 30 F.3d 1475, 31 USPQ2d 1671 (Fed. Cir. 1994); *In re Spada,* 911 F.2d 705, 15 USPQ2d 1655 (Fed. Cir. 1990). Alternatively, anticipation requires that **each and every element of the claimed invention be embodied in a single prior art device or practice**. *See, e.g., Minnesota*

Min. & Mfg. Co. v. Johnson & Johnson Orthopaedics, Inc., 976 F.2d 1559, 24 USPQ2d 1321 (Fed. Cir. 1992). **For anticipation, there must be no difference between the claimed invention and the reference disclosure, as viewed by a person of** ordinary skill in the field of the invention. See, e.g., Scripps Clinic & Res. Found. v. Genentech, Inc., 927 F.2d 1565, 18 USPQ2d 1001 (Fed. Cir. 1991). (Emphasis added in each instance.)

Claim 1 is drawn to a patient evaluation apparatus, and includes, inter alia:

"...***a dynamic generator to create a marked up document*** based upon the form data; and

a transmitting module **to combine the marked up document with medical data of a patient and transmitting the combined marked up document** through a transmission channel, such that **a user having a browser is capable of receiving and displaying the combined marked up document.**"

Claims 8, 14, 19 and 25 include similar features.

As described in the filed application at page 10, paragraph [0020] "Generator 130 performs a dynamic code generating operation, whereby form data is retrieved from configuration module 150, and each HTML/ASP page document may be generated based thereon." Accordingly, document ***generation*** is effected in a dynamic manner.

The Office Action asserts that the noted feature of claim 1 (as well as the similar features of claims 8, 14, 19 and 25) is disclosed by Taylor, at column 8, lines 21-22 and 34-37; and in Fig 4, block 2. Notably, however, the Office Action does not cite with specificity which components of Taylor are allegedly elements of the claims. For example, the Office Action does not specifically cite which component of Taylor is allegedly the claimed dynamic generator.

Moreover, in the Response to Applicant's Arguments, the Examiner asserts that "...for the 'marked-up' component, Applicant is directed to the passages provided for the rejection of feature 1c." Applicants would like the present record to reflect that the rejection of feature 1c, directs the reader to column 8, lines 20-28 and 34-37; Fig. 4, Blocks 2-4 and 7.

In the interest of completeness of discussion, Applicants reproduce verbatim column 8, lines 14-38 of Taylor:

> **FIG. 4 is a block diagram for transmitting a document between computers according to the method and system of a preferred embodiment of the present invention.**
>
> **Block 1 represents a computer that transmits a document to a separate computer.**
>
> **Block 2 represents the document assembly instructions, and the format and content information applicable to all documents of a particular document type.**
>
> **Block 3 represents the document-specific content for an individual document stored in the relational database.**
>
> **Block 4 represents the process whereby an electronic file is created to store the document-specific content in a condensed format using well known computer principles and techniques.**
>
> **Block 5 represents a computer network or a physical or other standard computer mechanism for transferring an electronic file from one computer to another computer.**
>
> **Block 6 represents a computer that receives a document transmitted from a separate computer.**
>
> **Block 7 represents a process whereby the data represented in Blocks 2 and 4 are combined to assemble a complete document identical to that assembled in the computer that transmitted the data.**

As disclosed in the noted portion of Taylor, Fig. 4 is a block diagram for transmitting documents between two computers. Block 1 represents a computer that transmits the documents and Block 6 represents the computer receiving the instructions. While the reference does disclose that Block 2 and 4 disclose the assembling, and storing document specific content, Applicants respectfully submit that the noted portion of Taylor does not disclose the featured dynamic generator that creates a marked up document. Stated differently, the reference to Taylor as relied upon merely transmits an assembled document, but does not include a generator that created a marked up document as claimed.

As such, Applicants respectfully submit that Blocks 2 and 5 do not teach or suggest at least the creation of a marked up document based upon form data.

Accordingly, Applicants respectfully submit that the reference to Taylor does not disclose at least the noted feature of claims 1; or the like features of 8, 14, 19 and 25. Therefore, Applicants respectfully submit that a prima facie case of anticipation has not been established and the independent claims are patentable over the applied art. Moreover, claim 2-7, 9-13, 15-18 and 26-29, which depend from claims 1, 8, 14, 19 and 25, respectively, are also patentable over the applied art. Allowance is earnestly solicited.

Rejections Under 35 U.S.C. § 103

Claims 6 and 18 were rejected under 35 U.S.C. § 103(a) as being obvious over Taylor and Myers, et al. (U.S. Patent Publication Number 2002/0004806). As noted previously, claims 6 and 18 depend from independent claims 1 and 14, which for reasons set forth above are patentable over the applied art. As such, and while in no way conceding the propriety of this rejection, Applicants respectfully submit that this rejection is improper and should be withdrawn.

Conclusion

In view the foregoing, applicant(s) respectfully request(s) that the Examiner withdraw the objection(s) and/or rejection(s) of record, allow all the pending claims, and find the application in condition for allowance.

If any points remain in issue that may best be resolved through a personal or telephonic interview, the Examiner is respectfully requested to contact the undersigned at the telephone number listed below.

Respectfully submitted on behalf of:

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